

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 555255-012729
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>April 17, 2009</u>		Application Number 10/786,961
Signature <u>Debra Pejeau</u>		Filed 02/25/2004
Typed or printed Debra Pejeau name		First Named Inventor David R. Clark
		Art Unit 2617
		Examiner Addy, Anthony S.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

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applicant/inventor.

/Joseph M. Sauer/

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Joseph M. Sauer

Signature

Typed or printed name

☒

attorney or agent of record.

Registration number 47,919

216-586-7506

Telephone number

☐

attorney or agent acting under 37 CFR 1.34.

04/17/2009

Date

Registration number if acting under 37 CFR 1.34 _____

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below*.

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*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 555255-012729

Group Art Unit:	2617)	
)	
Examiner:	Anthony Addy)	
)	
Inventor:	David R. Clark, et al.)	
)	
Serial No.:	10/786,961)	PRE-APPEAL BRIEF
)	REQUEST FOR REVIEW
Filed:	Feb. 25, 2004)	
)	
For:	Mobile Device Programming)	
	System and Method)	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Claims 1, 4-6, 16, 48-50, and 53 stand finally rejected under 35 U.S.C. § 103(a). The rejection of the pending claims is now appealed. Applicant hereby requests review of the final rejection prior to filing an appeal brief because the rejection fails to prove a *prima facie* case of unpatentability and there is clear error in the rejection of these claims. Any fees due should be charged to Jones Day Deposit Account No. 501432, ref: 555255-012729.

**The Rejection of Independent Claim 1 Is Clearly Erroneous because
the Cited References Fail to Disclose Every Element of the Claim**

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2004/0192282 (Vasudevan) in view of U.S. Patent No. 5,008,814 (Mathur) and further in view of U.S. Publication No. 2004/0243993 (Okonnen). With regard to the combination of Vasudevan and Mathur, the office action admits that the combination of

references fails to teach numerous claim limitations:

[The combination of Vasudevan and Mathur] fails to explicitly teach determining whether an update resource is stored in the mobile device memory during an initialization of the mobile device; upon determining that the update resource is stored in the mobile device memory during an initialization of the mobile device, prompting a mobile device user to select one of the baseline mobile device configuration or updated mobile device configuration; and accepting the updated mobile device configuration or reverting to the baseline mobile device configuration based on the user selection. (Office Action, p. 5.)


The office action cites to Okonnen as allegedly teaching the missing subject matter from both Vasudevan and Mathur. Specifically, the office action cites paragraphs 55 and 57-59 of Okonnen. Okonnen, though, does not disclose the subject matter that is absent from Vasudevan and Mathur. As noted above, claim 1 recites “prompting a mobile device user to select one of the baseline mobile device configuration or updated mobile device configuration and accepting the updated mobile device configuration or reverting to the baseline mobile device configuration based on the user selection.” By contrast, the cited passages from Okonnen make clear that there is no “prompt” to a mobile device user to select one of a baseline configuration or an updated configuration, nor is an updated configuration “accepted” or a reversion to a baseline configuration made based on a choice by the mobile device user. Thus, the final two steps of claim 1 are clearly missing from Okonnen.

The cited passages from Okonnen teach that a user is presented with “[a] list of provisioned update agents,” and if the user selects an update agent, “the UA loader 127 may invoke the selected provisioned update agent and transfer control to the selected update agent.” (Okonnen, ¶ 58.) Okonnen also teaches, though, that a particular update agent is used to update a particular aspect of the mobile handset, a fact that the office action acknowledges when it states, “based on the selection by the end-user, an update to a particular firmware, software, hardware configuration, etc., in the mobile handset is performed.” (Office Action, p. 6.) This is

not the same as the “prompting” and “accepting” steps recited in claim 1. As recited elsewhere in claim 1, “the baseline mobile device configuration is maintained within the mobile device memory for a period of time sufficient to allow the updated mobile device configuration to be tested.” That is, both the baseline configuration and the updated configuration are maintained on the mobile device, and the user is then prompted to select one of the configurations, either accepting the updated configuration or reverting to the baseline configuration. Merely teaching that a user may selectively update one of several aspects of a mobile handset in no way teaches the subject matter admittedly missing from the Vasudevan and Mathur references. For at least these reasons, Applicant submits that the cited references fail to teach every element of claim 1. Thus, claim 1 is allowable and should proceed to issuance.

Independent claims 48 and 53 recite subject matter analogous to the subject matter of claim 1 against which Okonnen was cited, and the office action relies on Okonnen in rejecting these claims. Therefore, claims 48 and 53 are allowable for at least the same reasons as claim 1, and they too should proceed to issuance. Further, each of the dependent claims in the instant application ultimately depends from an independent claim that is allowable, so the dependent claims are also allowable for at least the same reasons as the independent claims. The Panel is therefore respectfully requested to withdraw the rejection of claims 1, 4-6, 16, 48-50, and 53 and pass this case to issue.

Respectfully submitted,
JONES DAY



Joseph M. Sauer (Reg. No. 47,919)
Jones Day
North Point, 901 Lakeside Avenue
Cleveland, Ohio 44114
(216) 586-3939